

### REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicant respectfully submits that the pending claims comply with 35 U.S.C. § 112, are not anticipated under 35 U.S.C. § 102 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicant respectfully requests that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.

The applicant will now address each of the issues raised in the outstanding Office Action. Before doing so, however, the undersigned would like to thank Examiner Smith and Primary Examiner Leubecker for courtesies extended during a telephone Interview on August 2, 2006, as well as follow-up discussions on August 3, 2006 (referred to collectively as "the telephone interview"). The substance of the telephone interview is discussed below.

#### Rejections under 35 U.S.C. § 102

Claims 1, 5-10, 12 and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,491,628 ("the Kobayashi patent"). The applicant respectfully requests that the Examiner reconsider and

withdraw this ground of rejection in view of the following.

**Claims 1, 5-10 and 12**

Regarding independent claims 1 and 10, during the telephone interview, Examiner Smith clarified his position. Basically, Examiner Smith indicated that his position is that, in the Kobayashi patent, (1) the type of CCD affects the image-area (NA) displayed (See, e.g., column 6, lines 61-64.), (2) given the touch panel in Figure 11, each displayed pixel is selectable by a user and provides a directive, and (3) since pixels within the image-area (NA) are displayed and pixels outside the image area are not displayed, the display of the directives (i.e., pixels outside the image area (NA)) is restricted. (See, for example, column 15, lines 6-45.) Examiner Smith specifically cited column 15, lines 31-42 of the Kobayashi patent which states:

Similar to the first embodiment, in the positioning-memory 35, display-area (herein, the image-area NA) data corresponding to the pixel number of the CCD 12 in the video-processor 10 is stored, and then it is determined by the system control circuit 34 whether the touched position is in the image-area NA (See FIG. 2). *When the touched position is in the image-area NA, the magnifying process similar to the first embodiment is performed.* At this time, a pixel corresponding to the touched position is defined to a center of the magnified-display subject image. *On the other hand, when the touched position is outside the image-area NA, the magnifying*

*process is not performed.* [Emphasis added.]

The undersigned discussed with Examiner Smith possible amendments to the claims to more clearly distinguish them over the Kobayashi patent. Specifically, with regard to independent claims 1 and 10, the undersigned suggested one possible amendment further reciting that the directive display unit *displays directives apart from an image produced by the image video signal*. Examiner Smith felt that such amendments would help to distinguish the claims over the Kobayashi patent, but mentioned that he would need to review all parts of the Kobayashi patent and update his prior art search.

Independent claims 1 and 10 have been amended as discussed. These amendments distinguish the claimed invention over the Kobayashi patent. Accordingly, the applicant respectfully submits that these claims, as amended, are not anticipated by the Kobayashi patent. Since claims 5-9 and 12 depend, either directly or indirectly, from claim 1, these claims are similarly not anticipated by the Kobayashi patent.

#### ***Claim 14***

Regarding independent claim 14, during the telephone interview, Examiner Smith clarified his position. Basically, Examiner Smith posits that column 7 of the Kobayashi patent shows that shift keys can be used to move the position of a pointer P, but that this movement is restricted so that it cannot be moved outside the image area NA (and therefore the operation of the shift

keys is restricted based on the image area NA, which is based on the CCD).

During the telephone interview, the undersigned suggested that amending claim 14 to specify that the switch is a *mode selection switch (e.g., mask size - endoscope image size interlock on/off, enlarge, zoom on/off)* would distinguish it from the shift keys in the Kobayashi patent which are used to move a pointer. Examiner Smith agreed, but mentioned that he would need to review all parts of the Kobayashi patent and update his prior art search.

Independent claim 14 has been amended as discussed. This amendment distinguishes the claimed invention over the Kobayashi patent. Accordingly, the applicant respectfully submits that claim 14, as amended, is not anticipated by the Kobayashi patent.

#### Rejections under 35 U.S.C. § 103

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the Kobayashi patent. The applicant respectfully requests that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The Examiner contends that the signal processing unit of the Kobayashi patent can inherently implement basic features and perform extension processing on the image signal, and that it would have been obvious to construct a signal processing unit on a main board and an expansion board. (See Paper No. 20060414, page 6.) Even assuming, arguendo, that the Examiner is correct, the purported teaching and purportedly obvious modification

still do not compensate for the deficiencies of the Kobayashi patent with respect to claim 1, discussed above. Since claim 3 depends from claim 1, it is not rendered obvious by the Kobayashi patent for at least this reason.

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the Kobayashi patent in view of U.S. Patent No. 6,692,432 ("the Yarush patent"). The applicant respectfully requests that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The Examiner concedes that the Kobayashi patent does not teach a directing unit that comprises an LED on the front panel and that the restricting unit restricts the lighting of the LED. In an attempt to compensate for this admitted deficiency, the Examiner relies on the Yarush patent. Specifically, the Examiner contends that the Yarush patent discloses a directing unit including an LED on a front panel, the lighting of which may be restricted by an ON/OFF switch, and further contends that it would have been obvious to provide such an LED in order to indicate the status of a power supply. (See Paper No. 20060414, pages 7 and 8.)

First, the applicant respectfully notes that the ON/OFF switch cannot function as the claimed restricting unit, and would destroy the restricting unit functionality of the Kobayashi patent alleged by the Examiner. Thus, claim 11 is not rendered obvious by the Kobayashi and Yarush patents for at least this reason.

Second, even assuming, arguendo, that the Examiner is correct, the purported teaching of the Yarush patent

and purportedly obvious modification still do not compensate for the deficiencies of the Kobayashi patent with respect to claim 1, discussed above. Since claim 11 depends from claim 1, it is not rendered obvious by the Kobayashi and Yarush patents for at least this additional reason.

Claim 13 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the Kobayashi patent in view of U.S. Publication No. 2003/0197781 ("The Sugimoto Publication"). The applicant respectfully requests that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The Examiner concedes that the Kobayashi patent does not disclose that the unavailability of directives in a directive display unit is indicated by hatching. In an attempt to compensate for this admitted deficiency, the Examiner relies on the Sugimoto publication as teaching this feature, and contends that it would have been obvious to provide hatching in the display as it is a well-known way to indicate unavailability. (See Paper No. 20060414, page 8.)

First, the hatched portion 72 is in a Figure of the Sugimoto publication, not a display. Thus, claim 13 is not rendered obvious by the cited references for at least this reason.

Second, even assuming, arguendo, that the Examiner is correct, the purported teaching of the Sugimoto publication and purportedly obvious modification still do not compensate for the deficiencies of the Kobayashi patent with respect to claim 1, discussed above. Since claim 13 depends from claim 12, which depends from claim

1, it is not rendered obvious by the Kobayashi patent and Sugimoto publication for at least this additional reason.

#### New claims

New claim 15 depends from claim 1 and further recites that the directive unit displays directives on LEDs separate from an image produced by the image video signal displayed on a display screen. New claim 16 depends from claim 1 and further recites that the directive unit displays directives on a same display screen as an image produced by the image video signal. These claims further distinguish the claimed invention over the Kobayashi patent. These claims are supported, for example, by Figs. 5A-5C and 9, as well as page 32, line 3 et seq.

New claims 17 and 18 are similar claims 15 and 16, respectively, but depend from claim 10.


New claim 19 depends from claim 14 and further recites that the selected mode is at least one of (A) a mask size, (B) endoscope image size interlock ON/OFF, (C) enlarge ON/OFF, and (D) zoom ON/OFF. This claim further distinguishes the claimed invention over the Kobayashi patent. This amendment is supported, for example, by page 26, line 20 through page 29, line 13.

Conclusion

In view of the foregoing amendments, the applicant respectfully submits that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

Respectfully submitted,

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